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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,528	07/15/2003	Dean Kerkhoff	02-344-J	2114
31718	7590	04/28/2005	EXAMINER	
BELASCO, JACOBS & TOWNSLEY LLP HOWARD HUGHES CENTER 6100 CENTER DRIVE SUITE 630 LOS ANGELES, CA 90045			HSIEH, SHIH YUNG	
			ART UNIT	PAPER NUMBER
			2837	

DATE MAILED: 04/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

EK

Office Action Summary	Application No. 10/620,528	Applicant(s) KERKHOFF, DEAN	
	Examiner Shih-yung Hsieh	Art Unit 2837	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/22/2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-31 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 6, 10, 14, 15 and 19 is/are rejected.
- 7) ☒ Claim(s) 4, 7-9, 11-13, 16-18, 20-22, and 32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2837

1. Claim 32 is objected to because of the following informalities: claim 32 depends on claim 33. There is no claim 33. Appropriate correction is required.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Leonard (3,728,931).

Regarding claim 1, Leonard discloses a piano key finder and chord indicator (Figs. 1 and 3) comprising means for displaying alphabetic representation of a chromatic scale (28, 29) associated with a selected musical key; means for displaying alphabetic representation of major and minor chord (40, 42) associated with said selected musical key; means for indicating piano keys (36, 38) associated with the chromatic scale associated with said selected key.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-3, 6, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson (4,960,029) in view of Leonard.

Regarding claims 2 and 3, Nelson discloses a piano key and chord indicator comprising an outer sleeve (23 in Fig. 2), an interior cavity (Fig. 2 shows an interior cavity for a slider member 12); first and second sets of openings (28, the openings above and below window 32 shown in Fig.1); a slider member (12) and means (14, 16) for preventing the slider member from being removed from the outer sleeve; said slider member having a first portion (18) and a second portion (20); said first portion carrying alphabetic representations (Figs. 3-5) being sized and shaped to be visible through said first set of openings in said outer sleeve (Fig. 1); said second portion having a first series of markings (Figs. 3-5) being sized and shaped to be visible through said second set of openings in said outer sleeve.

The difference between Nelson's indicator and claim 2 is that claim 2 recites said outer sleeve having a representation of a portion of a piano keyboard, indicating piano keys with the chromatic scale associated with said selected musical key.

Leonard teaches an outer sleeve (10 in Fig. 3) having a representation of a portion of a piano keyboard (38), indicating piano keys with a chromatic scale (30) associated with a selected musical key for teaching a student to identify positional relationship of the tones in different scales (col. 1, lines 38-45). It would have been obvious to one having ordinary skill in the art to modify Nelson's indicator as taught by Leonard to include said outer sleeve having a representation of a portion of a piano keyboard, indicating piano keys with the chromatic scale associated with said selected

musical key for the purpose of teaching a student to identify positional relationship of the tones in different scales.

The rest of the claim is the intended use of the indicator that does not carry any patentable weight. Further, the combination of the references teaches the same.

Regarding claim 6, Nelson discloses the second set of openings in the outer sleeve are of a first predetermined shape (Fig. 1).

Regarding claim 14, it is obvious to an ordinary skill in the art that the combination of references teach the method steps. See above reasoning.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Leonard as applied to claims 1 and 2 above, and further in view of Winn (5,731,572).

Regarding claim 5, Nelson in view of Leonard disclose the claimed invention except that at least one finger notch being disposed at either of said first and second ends of said outer sleeve.

Winn teaches at least one finger notch (38) being disposed at either of first and second ends of an outer sleeve (22) for allowing a user to more easily grasp a sliding member (20) (col. 4, lines 1-5). It would have been obvious to one having ordinary skill in the art to modify Nelson in view of Leonard's indicator as taught by Winn to include at least one finger notch being disposed at either of said first and second ends of said outer sleeve for the purpose of allowing the user to more easily grasp a sliding member.

7. Claims 10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of Leonard as applied to claims 1 and 2 above, and further in view of Rackow (6,323,410).

Regarding claim 10, Nelson in view of Leonard disclose the claimed invention except that the first series of markings are of a first predetermined color.

Rackow teaches a first series of markings (Fig. 1) are of a first predetermined color (col. 3, lines 65-66) for contrasting the major key (col. 3, lines 64-6). It would have been obvious to one having ordinary skill in the art to modify Nelson in view of Leonard's indicator as taught by Rackow to include the first series of markings are of a first predetermined color for the purpose of contrasting the major key.

Regarding claim 19, it is obvious to an ordinary skill in the art that the combination of the references teach the method of providing the first set of markings in a first predetermined color.

8. Claims 4, 7-9, 11-13, 16-18, and 20-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claims 23-31 are allowed.

10. Applicant's arguments filed 3/22/2005 have been fully considered but they are not persuasive.

The applicant argued that Leonard is definitely not a piano key finder and chord indicator. The examiner disagrees.

The title of the reference does not have to be the same as the preamble of the invention as long as the device in the reference has the same construction, in the same class and subclass of the art, and discloses the same means and function as recited in claim 1. In this case, the reference reads on claim 1, and the combination of references read on the dependent claims, therefore, the rejections stand.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shih-yung Hsieh whose telephone number is 571-272-2065. The examiner can normally be reached on 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Martin can be reached on 571-272-2107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

syh


SHIH-YUNG HSIEH
PRIMARY EXAMINER